REMARKS

The Office Action dated March 19, 2009, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1-11, 15, and 21-27 are currently pending in the application, of which claims 1, 9, 11, and 15 are independent claims. Claims 1, 9, 11, and 15 have been amended to more particularly point out and distinctly claim the invention. No new matter has been added. Claims 1-11, 15, and 21-27 are respectfully submitted for consideration.

An interview was conducted on May 28, 2009, between the Examiner and Applicants' representative. Applicants thank the Examiner for the courtesies and dialog provided to Applicants' representative during the interview. The interview discussed the art-based rejections. This discussion is expounded upon below. Reconsideration of the rejections and timely allowance of the claims is respectfully requested.

The Office Action rejected claims 1-8, 11, and 21-27 under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. Specifically, the Office Action alleged that claims 1-8 are method claims that do not pass the "machine-or-transformation" test and that claims 11 and 21-27 recite only software. Applicants respectfully submit that the claims recite statutory subject matter.

Claim 1 presently recites that the data involved in the claimed method is "data to be supplied to database operations in a domain name server." As such, the method is tied to a specific machine a "domain name server" that should be deemed to pass the

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"machine" portion of the "machine-or-transformation" test. Applicants note that the method may alternatively be deemed statutory subject matter because it passes the "concrete, useful, tangible result" test by "supplying the data to database operations" as recited in claim 1. Although the recent Federal Circuit decision in *Bilski* has criticized the "concrete, useful, tangible result" test, the *Bilski* decision itself is under review by the U.S. Supreme Court and arguably is bad law in limiting the available tests to the machine-or-transformation" test, since Supreme Court precedent made clear that such is not the only test of patentability.

Claim 11 is a claim to an apparatus and claims 21-27 depend therefrom. Although the Office Action has asserted that the terms "interfaces" and "converters" "may simply be software elements," it is respectfully submitted that this is incorrect. In particular, it is respectfully submitted that pure software in the ether cannot "receive data" or "conditionally convert" that data, nor can pure software in the ether "supply the data to database operations." All these activities require the presence of some hardware. In the context of the claim, which is directed to an apparatus, one of ordinary skill in the art would therefore interpret at least the interfaces as involving hardware aspects, whether or not the "interface" itself is primarily hardware or software.

Indeed, it is respectfully submitted that one of ordinary skill in the art, reading the terms "converter" and "interface" in the context of claim 11 would consider them to relate to hardware devices (devices that may or nor be further equipped with software). Even if those terms can mean pure software in other contexts (not admitted), in the

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context of a claim where the preamble is "apparatus" a good faith and reasonable interpretation of the terms must be understood as referring to the machine components of the apparatus.

In view of the above, each of the presently pending claims recites patent-eligible subject matter. Thus, for each of the reasons set forth above, it is respectfully requested that the rejections for alleged lack of subject matter be withdrawn.

The Office Action rejected claims 1-11, 15, and 21-27 under 35 U.S.C. §103(a) as being allegedly unpatentable as obvious over U.S. Patent No. 6,963,928 of Bagley *et al.* ("Bagley") in view of U.S. Publication No. 2003/0007482 of Khello *et al.* ("Khello"). The Office Action acknowledged that Bagley does not disclose or suggest all of the features recited in the claims, but cited Khello to remedy certain deficiencies of Bagley. Applicants respectfully submit that the claims recite subject matter that is neither disclosed nor suggested in the cited art.

Claim 1, upon which claims 2-8 depend, is directed to a method including receiving data to be supplied to database operations in a domain name server, the data including at least one Internet domain name comprising a plurality of successive labels separated by dots, said at least one Internet domain name being in a first format, wherein the at least one Internet domain name comprises at least one hostname and at least one top-level domain name. The method also includes conditionally converting at least one of said at least one Internet domain name into a second format of Internet domain name in which at least two successive labels of the at least one of said at least one Internet

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domain name are combined to form a single label, wherein the conditionally converting comprises converting the Internet domain name when the Internet domain name fulfills a predetermined condition. The method further includes supplying the data to the database operations, the supplied data including at least one Internet domain name in the second format.

Claim 9, upon which claim 10 depends, is directed to a system including receiving means for receiving data to be supplied to database operations in a domain name server, the data including at least one Internet domain name comprising a plurality of successive labels separated by dots, said at least one Internet domain name being in a first format, wherein the at least one Internet domain name comprises at least one hostname and at least one top-level domain name. The system also includes converting means for conditionally converting at least one of said at least one Internet domain name into a second format of Internet domain name in which at least two successive labels of the at least one of said at least one Internet domain name are combined to form a single label, wherein the second means is configured to convert the Internet domain name when the Internet domain name fulfills a predetermined condition. The system further includes supplying means for supplying the data to database operations, the supplied data including at least one Internet domain name in the second format.

Claim 11, upon which claims 22-27 depend, is directed to an apparatus including a first interface configured to receive data to be supplied to database operations in a domain name server, the data including at least one Internet domain name comprising a plurality

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of successive labels separated by dots, said at least one Internet domain name being in a first format, wherein the at least one Internet domain name comprises at least one hostname and at least one top-level domain name. The apparatus also includes a converter configured to conditionally convert at least one of said at least one Internet domain name into a second format of Internet domain name in which at least two successive labels of the at least one of said at least one Internet domain name form a single label, wherein the modification module is configured to convert the Internet domain name when the Internet domain name fulfills a predetermined condition. The apparatus further includes a second interface configured to supply the data to database operations, the supplied data including at least one Internet domain name in the second format.

Claim 15 is directed to an apparatus including first interface means for receiving data to be supplied to database operations in a domain name server, the data including at least one Internet domain name comprising a plurality of successive labels separated by dots, said at least one Internet domain name being in a first format, wherein the at least one Internet domain name comprises at least one hostname and at least one top-level domain name. The apparatus also includes modification means for conditionally converting at least one of said at least one Internet domain name into a second format of Internet domain name in which at least two successive labels of the at least one of said at least one Internet domain name form a single label, wherein the modification means is configured to conditionally convert the Internet domain name when the Internet domain

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name fulfills a predetermined condition. The apparatus further includes second interface means for supplying the data to database operations, the supplied data including at least one Internet domain name in the second format.

Applicants respectfully submit that the combination of Bagley and Khello fails to disclose or suggest all of the elements of any of the presently pending claims.

Bagley generally relates to systems and methods for communicating across various communication applications using single address strings. More specifically, in Bagley systems and methods are discussed for providing addressing strings formats and associated system implementations to minimize the number of different addressing strings used for communicating across different communication applications. The systems and methods of Bagley receive a valid address string that can be inputted into a communication applications selected from a collection of communication applications wherein the same address string can be input for any selected communication application from that collection.

Claim 1 recites features relating to modifying an internet domain name by combining successive labels. Specifically, claim 1 recites, "conditionally converting at least one of said at least one Internet domain name into a second format of Internet domain name in which at least two successive labels of the at least one of said at least one Internet domain name are combined to form a single label." Bagley (whether considered alone or in combination with Khello) fails to disclose or suggest at least these features of claim 1.

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Bagley at column 8, lines 20-36 (relied upon in the Office Action) discusses operations done on a string. The string in question, however, is not an internet domain name. In fact the section (specifically lines 29-31) states that a section corresponding to a domain name is **removed** from the string. Furthermore, the resulting string of characters "1800JKL1234" is not a internet domain name, since internet domain names are made up of successive labels separated by dots, as explained at paragraph [0026], lines 1-6, of the present application. The dots of a domain name, as explained in the present application, are not arbitrary characters (as in Bagley) but have semantic significance *i.e.* meaning.

Furthermore, the entire issue of labels is not in the least hinted at in Bagley. In fact, the description and claims of Bagley do not even contain the term "label." Quite to the contrary, Bagley discloses something that approaches being the opposite of combining labels at column 9, lines 9-21, where strings are "segmented" by adding dots. Subsequently, the "segmented" string is converted to a domain name by adding a domain name, Column 9, lines 33-40. Taken together (and considered as a whole, as required by MPEP 2141 (II): "When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: ... (B)The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination ..."), what Bagley discusses at Columns 8-9 is converting a domain name to a string, modifying the string according to the translation table at Column 8, segmenting the resulting string by adding dots, and then converting it back to a domain name. Why Bagley believes that the

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"segments" so produced would happen to be valid labels is not discussed (as noted above, there is no discussion of labels in Bagley).

Thus, the approach of Bagley is radically different from the approach recited in the claims and discussed in the present application. For example, for the combination of labels according to certain embodiments of the present invention, please see Figures 2 and 3 of the present application. Thus, Bagley not only does not teach the claimed invention, Bagley teaches away from the claimed invention.

The Office Action did not rely on Bagley alone, but – as noted above – cited Khello to attempt to remedy certain deficiencies of Bagley. It is respectfully submitted that the combination of Bagley and Khello fails to disclose or suggest the claimed invention because Khello cannot reverse Bagley's teaching away nor can Khello otherwise remedy the deficiencies of Bagley.

Khello generally relates to a method and apparatus for resolving an entity identifier into an internet address using a domain name system (DNS) server and an entity identifier portability database. More specifically Khello relates to an allegedly efficient way of resolving telephone numbers and other entity/device identifiers into Internet addresses as well as accommodating portability of those telephone numbers and other entity/device identifiers without having to substantially modify or rework the domain naming system (DNS) infrastructure or established number portability schemes. Khello aims to implement self-contained, additional functionality on a DNS server to allow smooth IP address resolution of telephone numbers or other entity/device

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identifiers by taking advantage of existing portability databases. Allegedly, Khello's system does not impact the existing networks that create and maintain such portability databases.

The Office Action did not specifically cite Khello with respect to the features: "conditionally converting at least one of said at least one Internet domain name into a second format of Internet domain name in which at least two successive labels of the at least one of said at least one Internet domain name are combined to form a single label" as recited in claim 1. Thus, the above discussion should also serve to show that the combination of Bagley and Khello does not disclose these features of claim 1.

Nevertheless, the Office Action admitted that Bagley does not disclosed "separated by dots" as recited in claim 1. The Office Action took the position that Khello teaches "separated by dots" by suggesting to format a domain name in e164.arpa format into a telephone number by removing the dots and reversing the order of digits. The Office Action further stated that since Bagley teaches to remove "all other characters not included in the translation table such as hyphens and underlines" and since a period is not in the translation table, it would be obvious to remove the periods in performing Bagley's method. It is respectfully submitted, however, that even if all these statements are taken as true and admitted (which is not what Applicants are doing), the proposed "combination" would not in any way alter the fundamental operation of Bagley.

Additionally, the "combination" would appear contrary to common sense. If Bagley is just going to remove the periods, why would one of ordinary skill in the art

look to Khello for instruction to add them in the first place? Such a motivation does not seem to make sense. Thus, it is respectfully submitted that one of ordinary skill in the art would not be motivated to alter the fundamental operation of Bagley (which does not combine labels and doesn't even recognize the concept of labels) to arrive at the claimed invention.

Additionally, it is noted (for the sake of expediting prosecution) that Khello likewise contains not disclosure or suggestion of "conditionally converting at least one of said at least one Internet domain name into a second format of Internet domain name in which at least two successive labels of the at least one of said at least one Internet domain name are combined to form a single label" as recited in claim 1. Thus, one of ordinary skill in the art would not alternatively (starting from Khello's disclosure) combine some arbitrary features from Bagley into Khello to arrive at the claimed invention.

In short, the combination of Bagley and Khello or Khello and Bagley, or either of the references taken individually cannot disclose or suggest all of the features of claim 1. The other independent claims (claims 9, 11, and 15) each has its own respective scope. Nevertheless, for similar reasons, the Bagley and Khello cannot disclose or suggest the subject matter of each of those claims. Thus, it is respectfully requested that the rejections of all of claims 1, 9, 11, and 15 be withdrawn.

Furthermore, claims 2-8, 10, and 21-27 depend respectively from, and further limit, claims 1, 9, and 11. It is, therefore, respectfully submitted that claims 2-8, 10, and 21-27 recite subject matter that is neither disclosed nor suggested by the combination of
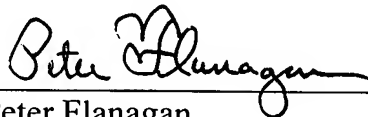
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Bagley and Khello. In view of at least these distinctions, it is respectfully requested that the rejection of all of claims 2-8, 10, and 21-27 be withdrawn.

For the reasons set forth above, it is respectfully submitted that each of claims 1-11, 15, and 21-27 recites subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that all of claims 1-11, 15, and 21-27 be allowed, and that this application be passed to issuance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

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